UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,233	04/05/2001	Cary Lee Bates	RSW920010047US1	7213

7590 09/11/2006	EXAMINER
Andrew M. Calderon	PWU, JEFFREY C
Greenblum and Bernstein P.L.C.	

ART UNIT	PAPER NUMBER
2143	

Andrew M. Calderon
Greenblum and Bernstein P.L.C.
1950 Roland Clarke Place
Reston, VA 20191

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 December 2005*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

2.   Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

invention. Claim 2 is vague and indefinite because it is unclear what is the association and/or

relationship between the web page and the email.

3.   Claims 1-3, 8-11, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Claim 1-3, 8-11, and 16 are vague and indefinite because it is

unclear what is a preferred viewing order.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-3, 5, 7, 9-11, 13, 15, and 17-20 are rejected under 35 U.S.C. 102(e) as being

anticipated by Carter (US 6,859,213).

As broadly drafted and as best the Examiner can ascertain from the language of the claims,

claims 1-3, 5, 7, 9-11, 13, 15, and 17-20 do not define any structure/step that differs from Carter.

Carter teaches claims:

1. A method for providing email that enables a recipient of the email to navigate readily through

a set of web pages associated with the email, comprising the acts of:

composing an email to be sent from an originator to a recipient; (abstract; "A method and

apparatus for selecting attachments. When a sender indicates in an e-mail application or applet

that an attachment is to be associated with an e-mail message, an attachment chooser window is

presented. The attachment chooser window provides a browser-based graphical user interface

(GUI) which allows a sender to browse data resources, such as HTML documents and associated

links. An attachment mechanism is provided by which a sender can choose a currently displayed

data resource for attachment in an e-mail message. In one embodiment, the attachment

mechanism allows a user to select whether the attachment is retrieved and attached to an e-mail

message as a resource locator (such as a URL) of the chosen data resource, or whether source

data of the data resource is retrieved and attached to the e-mail message as one or more source

files.")

in response to input of the originator, generating a web page navigation ("a browser-

based graphical user interface (GUI) which allows a sender to browse data resources ") that

includes a plurality of uniform resource locators and a preferred viewing order in which web

pages identified by the plurality of uniform resource locators are to be viewed by the recipient;

(col.3, lines 17-41)

associating the navigation with the email; and (307)

sending the email and the navigation to the recipient. (col.3, lines 17-41; col.4, line 45-

col. 5, line 26)

2. A method for guiding a recipient of an email readily through a set of web pages associated

with the email (Figs. 5A, 5B), comprising the acts of:

receiving an email; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

receiving a web page navigation associated with the email; (abstract; col.3, lines 17-41;

col.4, line 45-col. 5, line 26)

passing the web page navigation to a web browser; (abstract; col.3, lines 17-41; col.4,

line 45-col. 5, line 26)

displaying by the web browser (400) a preferred viewing order in which web pages

identified by the web page navigation are to be viewed; and (abstract; col.3, lines 17-41; col.4,

line 45-col. 5, line 26)

wherein the preferred viewing order is included in the navigation. ("Headers above the

message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and

"Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending

or descending date, by urgency, or by any combination thereof.")

3. A method for providing email that guides a recipient readily through a set of associated web

pages (Figs. 5A, 5B), comprising the acts of:

composing an email to be sent from an originator to a recipient; in response to input of

the originator, generating a web page navigation (400) that includes a plurality of uniform

resource locators that identify web pages to be viewed by the recipient in a preferred viewing

order; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

sending the email and the web page navigation to the recipient; passing the web page

navigation to a web browser used by the recipient; and displaying by the web browser an

indication of the preferred viewing order. ("Headers above the message list indicate such

information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the

list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency,

or by any combination thereof.")

5. The method of claim 3, wherein the indication of the preferred viewing order is provided by

icons. (216)

7. The method of claim 3, wherein the indication of the preferred viewing order is provided by

forward and backward browser controls. (403, 404)

9. Programmable media containing programmable software for providing email that guides a

recipient readily through a set of associated web pages, the programmable software comprising

the acts of:

composing an email to be sent from an originator to a recipient; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

in response to input of the originator, generating a web page navigation (400) that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;

associating the navigation with the email; and sending the email and the navigation to the recipient. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

10. Programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages (Figs. 5A, 5B), the programmable software comprising the acts of:

receiving an email; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

receiving a web page navigation associated with the email; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

passing the web page navigation to a web browser; and displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

wherein the preferred viewing order is included in the web page navigation. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

11. Programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages (Figs. 5A, 5B), the programmable software comprising the acts of:

composing an email to be sent from an originator to a recipient; in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

sending the email and the web page navigation to the recipient; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

passing the web page navigation to a web browser used by the recipient; and (passing 500 to 501)

displaying by the web browser an indication of the preferred viewing order. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

13. The method of claim 11, wherein the indication of the preferred viewing order is provided by icons. (216)

15. The method of claim 11, wherein the indication of the preferred viewing order is provided by forward and backward browser controls. (403, 404)

17. The method of claim 1, wherein the preferred viewing order is specified by the originator and the email sent to the recipient contains the plurality of uniform resource locators and the preferred viewing order. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

18. The method of claim 1, wherein an email program of the originator and a web browser of the originator together generate the web page navigation. (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

19. The method of claim 1, wherein the web page navigation is incorporated into the email sent to the recipient. (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

20. The method of claim 1, further comprising: receiving the email and the web page navigation

with an email program of the recipient; passing the web page navigation to a web browser of the

recipient; and displaying an indication of the preferred order with the web browser of the

recipient. ("Headers above the message list indicate such information as "Subject" 212,

"To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by

sender or receiver, by ascending or descending date, by urgency, or by any combination

thereof.")

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   Claims 4, 6, 8, 12, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Carter in view of Bates et al. (US 6,963901).

Cater discloses all of the claimed limitations except for a showing of a preferred viewing

order having various link colors and fonts.

Bates is applied for showing a browser program 240 (e.g. font, color, background, screen

sizing, display attributes and other user configurable settings; at col.4, lines 25-35, col. 4, line

57-col5 line 15) having preference file 244 for navigating web links.

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to use Carter's method and apparatus to select attachments to navigate readily through

a set of web pages associated with an email and to select any desirable view/diaplay order, as

taught by Bates, by incorporating a preferred colored links and/or fonts in order to provide a

visible mark to show the degree of importance and order ranking.

Response to Arguments

8.   Applicant's arguments with respect to claims 1-20 have been considered but are moot in

view of the new ground(s) of rejection.

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jeffrey C. Pwu whose telephone number is 571-272-6798. If

attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David

Wiley can be reached on 571-272-3923. The fax phone number for the organization where this

application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9/4/06

JEFFREY PWU
PRIMARY EXAMINER